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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/224,202	12/30/98	CARLSON	L 3123-233-1
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LMC1/0728

EXAMINER
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SNIEZEK, A

ART UNIT	PAPER NUMBER
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2753

DATE MAILED: 07/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/224,202

Applicant(s)

Carlson et al.

Examiner

ANDREW L. SNIEZEK

Group Art Unit

2753



☒ Responsive to communication(s) filed on Jun 5, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims <sup>126</sup>

☒ Claim(s) 47-106 is/are pending in the application.

Of the above, claim(s) 51, 52, 59, 60, 67-86, 89, 90, 99, 100, 107, 114, 116, 117 and 124 are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 47-50, 53-58, 61-66, 87, 88, 91-98, 101-106, 108-113, 115, and 118-123 are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 15

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant's election with traverse of specie 1 (figures 3, 4 and 8) in Paper No. 17 is acknowledged. The traversal is on the ground(s) that there must be a serious burden in examination for the restriction to be proper. This is not found persuasive because looking for numerous different specie is a serious burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. It is noted that applicant has stated in the election of Paper No. 17 that claims 47-50, 53-79, 81-106, 108-113, 115, 118-123 and 125 read on the elected specie. Examiner has reviewed the noted claims and found that not all the noted claims read on the elected specie. Claims 59, 60, 67-79, 81-86, 89, 90, 99 and 100 are directed to the use of a random data pattern or a linearly increasing data pattern which do not correspond to the two frequency data pattern of elected specie figure 4. Claims 59, 60, 67-79, 81-86, 89, 90, 99 and 100 are therefor also non-elected and will not be examined in this application. Claims 47-50, 53-58, 61-66, 87, 88, 91-98, 101-106, 108-113, 115, 118-123, 125 and 126 are directed to the elected specie and will be examined.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 47-50, 53-56, 108-113, 115, 118-123 and 126 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Claim 47 in addition to being ambiguous by providing at least four distinct possibilities of the placement of the signals is not supported by the specification as originally filed. Having a first pattern with a first frequency in the burst area and a second pattern with a second pattern in the AGC area is not disclosed by the specification. See page 19 and 31 for possible location of patterns. The specific location of the two patterns with respect to each other as set forth in claims 108-113, 115, 118-123 nor having both patterns used in servo positioning as set forth in claim 126 is not supported by the specification. The dependent claims 48-50 and 53-56 inherit the language of claim 47.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 47-50, 53-56, 61, 94 and 104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 sets forth "one of the first and second data patterns is located in one of the AGC and burst fields". This language is considered indefinite because of ambiguous meanings it provides. Claims 48-50 and 53-56 inherit the language of independent claim 47. It is not clear how the "transition detector", "counter" and "memory" as set forth in claims 61, 94 and 104 are used in combination with each other or exactly the purpose of each of these elements in the determination of proper flying height. Omitting essential structural cooperative relationships of

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elements, such omission amounting to a gap between the necessary structural connections is considered a incomplete claim. See MPEP § 2172.01.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 47-50, 53-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 47-50 and 53-56 of copending Application No. 09/439,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the present application are in the corresponding claims of the copending application, i.e., the present application is written broader than the copending application. Elimination of a element along with its function is obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 57, 58, 61- 65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57, 60, 64, 65 of copending

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Application No. 09/439,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because each although written slightly different are directed to detecting proper fly height of a head. The claimed calibration value as set forth in claims 64 and 65 is inherent in the contents of the memory as set forth in the copending application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 87, 88, 91-95, 97, 98, 101-105, 108-113, 115, 118-123, 125 and 126 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 47-76 of copending Application No. 09/439,702. Although the conflicting claims are not identical, they are not patentably distinct from each other because each contains limitations, although very slightly from claim to claim, determines the fly height of a head using a detection circuit that counts peaks. The claimed calibration value as set forth in claims 95 and 105 is inherent in the contents of the memory as set forth in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 66, 96 and 106 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over corresponding claimed groups as discussed above, and claimed in copending Application No. 09/439,702 in view of official notice. Claims 66, 96 and 106 further set forth the limitation of postponing a read and write operation if the head is not at an acceptable fly height. Copending application serial number 09/439,702 does

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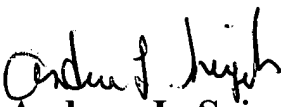
not specifically set forth this limitation. It is well known in the art that if it is determined that the head is not flying at a proper height that reading and writing would not be adequately performed and therefor such operation is stopped. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature in the arrangement as set forth in the present application to prevent errors in the reading and writing of data.

This is a provisional obviousness-type double patenting rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Snizek whose telephone and VoiceMail number is (703) 308-1602. If a plurality of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, H. Nguyen, can be reached on (703) 305-9687

The appropriate fax phone number for the organization (Group 2750) where this application or proceeding is assigned is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Andrew L. Snizek**  
**Primary Examiner**  
**Art Unit 2753**

A.L.S.  
July 25, 2000